

REMARKS

Claims 1-30, 32, 33, and 36-49 are pending in the application. Claims 1, 2, 15-18, 32, 33, 36, 38, 39, and 49 have been amended and claims 31, 34, and 35 have been cancelled by this response. Reconsideration and allowance of Applicant's claims are respectfully requested.

Applicant thanks Examiner Silbermann for granting an interview, and Applicant's representative thanks Examiner Silbermann for the courtesy extended during the interview February 23, 2005. The following remarks are made in light of the Examiner's suggestions made during the interview and the amendments to the claims.

Claims 1-49 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent 6,347,469 to Huellinghoff et al. ("Huellinghoff") and U.S. Patent 5,680,709 to Stone ("Stone"). It is respectfully submitted that rejection has been rendered moot in light of the amendment to the claims.

Huellinghoff describes a magnetic display 16 that includes a message sheet 18. The message sheet includes a message section 30 and a frame section. The message section includes a plurality of discrete regions 44 having a printed message. The printed message may include a pictorial portion and a worded portion. The frame section 32 may be separated from the message section 30. A frame member 52 having a window 60 may be separated from the frame section 32. The frame member 52 is magnetically attracted to the message section 30 and may be placed on the message section 32 such that the window 60 frames a message of the discrete region 44. The frame member 52 may include a worded phrase that when combined with the printed message of the discrete section 44 appearing in the window 60 creates a sentence (e.g., "I am" combined with and framing "out to lunch").

Stone describes an alignment device 20 to register a display panel 12 onto a magnetic backing panel 14 that is provided with an adhesive 16. The alignment device 20 includes walls 30 and 32 that surround the entire display panel 12 and magnetic backing panel 14 such that they are aligned when placed within the walls 30 and 32.

Applicant's claim 1 recites, among other things, "A user customizable, magnetic advertisement for a business comprising: a first magnetic layer having a first surface and a

second surface wherein, the first surface is divided into a first portion having a first dimension and a second dimension, the first and second dimensions generally forming a two dimensional rectangular shape substantially the size of a business card; a second portion including information related to the business; an adhesive affixed to the first portion having first and second dimensions substantially similar to the first portion and configured to receive the business card; and a protective layer affixed to the adhesive which may be removed to receive the business card, wherein the advertisement is customizable by removing the protective layer and affixing the business card." It is respectfully submitted that neither Huellinghoff nor Stone, alone or in combination, describe or suggest at least these features of Applicant's claim 1.

The purpose of message board described in Huellinghoff is to allow a user to display different messages by positioning the frame 52 over a discrete region 44. The Action purports that it would have been obvious to utilize the personal message of Stone by placing the display panel 12 on the message section 32 of Huellinghoff so that the message section 32 may be personalized.

Regardless of whether there is any suggestion to combine the two documents, the combination does not result in Applicant's claimed invention. For example, there is no description or suggestion of dividing Huellinghoff into two sections where the message section has substantially the dimensions of a business card. Furthermore, the combination of Huellinghoff and Stone teaches away from such dimensions. For example, if the display panel 12 of Stone were combined with the message section 32 of Huellinghoff, and both the panel and section had similar dimensions, all of the discrete regions 44 and their messages would be covered thereby rendering the message section 32 unfit for its intended use. Furthermore, the combination also would render the use of frame 52 useless because only a signal message would be displayed and that messages would not be fully displayed (since the window 60 would necessarily be smaller than the display panel 12). Similarly, there is no description or suggestion of forming an adhesive 16 of Stone over substantially the entire message section 32 since this also would interfere with the use of the frame 52 and would cover the discrete regions 44 and their messages. Therefore, Huellinghoff and Stone do not render claim 1 as obvious.

Claims 2-16 depend from claim 1 and are believed to be allowable for at least the reasons given above for claim 1.

Claim 17 recites, among other things, "A user customized magnetic advertisement for a business comprising: a first magnetic layer having a first surface and a second surface, the first surface further comprising: a first portion having a first dimension and a second dimension, the first and second dimensions generally forming a two dimensional rectangular shape substantially the size of a business card; an adhesive affixed to the first portion; and configured to receive and affix the business card to the adhesive; a second portion having a first dimension that is substantially similar to the first dimension of the first portion and including information related to the business, such that when the business card is affixed to the first portion, the customized magnetic advertisement presented by the first and second portions has a professional, finished appearance." It is respectfully submitted that neither Huellinghoff nor Stone, alone or in combination, describe or suggest at least these features of Applicant's claim 17.

As pointed out above, there is no description in Huellinghoff of creating the message section 32 having the dimensions substantially similar to that of a business card. Huellinghoff also fails to describe creating the section 30 having the same first dimension the message section 32 (e.g., the length of a business card). In fact, Huellinghoff teaches away from such dimensions because, as stated above, adding the display panel 12 of Stone would cover all the discrete regions 44 and their messages. In addition, such dimensions would mean that the frame 52 was smaller than the display panel 12 of Stone and, therefore, the window 60 would not frame the display panel 12. Therefore, Huellinghoff and Stone do not render claim 17 as obvious.

Claims 18-32 depend from claim 17 and are believed allowable for at least the reasons give above for claim 17.

Claim 33 recites, among other things, "A method of customizing a magnetic advertisement for a business, the method comprising: providing a magnetic layer including a first portion having a first dimension and a second dimension, the first and second dimensions generally forming a two dimensional rectangular shape substantially the size of a business card with an adhesive and a protective layer covering the adhesive and second portion having a first dimension that is substantially similar to the first dimension of the first portion including information relating to the business; removing the protective layer to expose the adhesive; affixing a business card, having a first dimension and a second dimension substantially similar to the first and second dimensions of the first portion, to the adhesive where the first dimension of

first dimension of the second portion, and the first dimension of the business card are aligned such that when the business card is affixed to the first portion by the adhesive, the customized magnetic advertisement presented by the first and second portions has a professional, finished appearance; and issuing the magnetic advertisement with affixed ~~medium~~ business card to current or prospective customers.” It is respectfully submitted that neither Huellinghoff nor Stone, alone or in combination, describe or suggest at least these features of Applicant’s claim 1.

Huellinghoff and Stone fail to describe providing the magnetic layer of claim 33 for the reasons given above for claim 17. Therefore, Huellinghoff and Stone do not render claim 33 as obvious.

It is respectfully submitted that claims 34-49 depend from claim 33 and are allowable for at least the reasons given above for claim 33. However, in addition, claim 36 recites, among other things, that “providing the second portion includes providing a coupon, the method further comprising: presenting the coupon to an issuer of the coupon; and redeeming the coupon in exchange for one of a free product, a free service, a discounted product, and a discounted service.” It is respectfully submitted Huellinghoff and Stone are silent with regard to distributing magnetic advertisements customized with a business card (affixed thereto with adhesive) where a portion of advertisement is a coupon and the coupon is redeemed for a free or discounted service or good. Furthermore, it is respectfully submitted that issuing, presenting and redeeming a coupon is a physical entity having a function, the function of which is recited in claim 36, and which is part of the advertising method that is claimed. Therefore, this feature of Applicant’s claim cannot be simply dismissed a “printed matter.”

Similarly, claim 38 recites, among other things, that “providing the second portion includes providing a coupon, the method further comprising: separating the first and second portions; presenting the coupon to an issuer of the coupon; and redeeming the coupon in exchange for one of a free product, a free service, a discounted product, and a discounted service.” It is respectfully submitted that Huellinghoff and Stone are silent with regard to at least these features of Applicant’s claim 38.

Finally, claim 39 recites, that “providing the second portion includes providing a service reminder, the method further comprising configuring the service reminder to indicate when to seek service, and presenting the service reminder to a customer with the business card affixed.”

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It is respectfully submitted that Huellinghoff and Stone are silent with regard to at least these features of Applicant's claim 39.

It is respectfully submitted that Huellinghoff and Stone do not support a *prima facie* case of obviousness with regard to Applicant's claimed invention, as neither Huellinghoff, nor Stone, alone or in combination, describe or suggest all features of Applicant's claims. Therefore, it is respectfully requested that the rejection of claims 1-30, 32, 33, and 38-49 be reconsidered and withdrawn.

It is respectfully submitted that all claims are in condition for allowance, and early notice of the same is respectfully solicited. If any questions remain, the Examiner is invited to contact the undersigned attorney at the telephone number listed above.